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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/850,263	05/07/2001	Jennifer A. Jacobi	AMAZON.008C1	1552

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EXAMINER

CHAMPAGNE, DONALD

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/850,263

Applicant(s)

JACOBI ET AL.

Examiner

Donald L. Champagne

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*[Handwritten signature]*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 61-103 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 61-67, 69-83 and 85-103 is/are rejected.
- 7) ☒ Claim(s) 68 and 84 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5-18-04.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION*****Response to Arguments***

1. Applicant's arguments filed with an amendment on 18 May 2004 have been fully considered, but most are moot in view of the new basis of rejection. Still relevant is applicant's point (p. 9, first full para.) that the instant invention is especially well suited to a large population of users and a large catalog of items. This could be a basis for commercial success, which is a possible argument against obviousness (MPEP § 716).

***Claim Objections***

2. Claim 82 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Mere possession of a system capable of performing the method of parent claim 61 would infringe claim 82, but not claim 61. See MPEP § 608.01(n).II and III. Applicant is required to cancel the claim(s) or rewrite the claim(s) in independent form.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
4. Claims 61-67, 69-83 and 85-103 are rejected under 35 U.S.C. 103(a) as being obvious over Whiteis in view of Tagawa (US005732398A).
5. Whiteis teaches (independent claims 61, 83, 87 and 97) a method and system for recommending items to users, and mapping items to related items, the method comprising: maintaining *links table 301* (col. 3 lines 43-45), which reads on maintaining "item selection histories", because said table is comprised of item selection histories, of each of a plurality of users of *processor 2* that provides functionality for browsing (col. 6 lines 48-51) and selecting items from an electronic catalog of items (*NAMES table 251*, col. 3 lines 27-28);

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building and updating *links table 301* (col. 3 lines 43-51), which reads on collectively analyzing at least the item selection histories of the plurality of users, as collected over a period of time, in an off-line processing mode, to generate a plurality of data values (*Link Weights 304*) that represent degrees to which specific items in the electronic catalog are related; storing selected data values in a mapping structure (*links table 301*, Fig. 8) that maps items to related items; for each of a plurality of users of the electronic catalog, using the mapping structure, including the data values stored therein, to generate personalized recommendations of items within the catalog (col. 4 line 28-30 and 44-53). For claim 97, *Input table 201* (col. 4 lines 42-44) reads on an electronic shopping cart.

6. Interpretation of "item selection histories". Unless a term is given a "clear definition" in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so "with reasonable clarity, deliberateness, and precision" (MPEP § 2111.01.III). A "clear definition" must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ...".
7. The instant application contains no such clear definition for the phrase "item selection histories". Indeed, the examiner could not find this phrase in the disclosure. The phrase is supported by a reference to maintaining "the user's purchase history" in a user profiles database.<sup>1</sup> But that is an example usage, and does not meet the requirements for a "clear definition." In the instant case, the examiner is required to give the term "item selection histories" its broadest reasonable interpretation, which the examiner judges to be any collection comprising item selection histories. Those skilled in the art would recognize that maintaining a processed reduction of "item selection histories", as *links table 301* does, reads on maintaining item selection histories, in much the same fashion that smoked fish reads on fish.

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<sup>1</sup> Col. 7 lines 45-53 of the parent patent, US006317722B1.

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8. Whiteis does not teach that the processor (*processor 2*) used to provide functionality for browsing and selecting items from an electronic catalog of items is a server. Tagawa teaches file server 112 (col. 10 lines 21-22) to provide functionality for browsing and selecting items from an electronic catalog of items (col. 10 lines 24-29). Because it provides economies of scale to use a central file server for storage of the electronic catalog of items, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Tagawa to those of Whiteis.
9. Whiteis also teaches at the citations given above claims 66, 67, 70, 74, 81, 82, 86, 88, 94, 95, 99 and 100.
10. Whiteis also teaches claims 69, 71, 72, 85, 89 and 96 (col. 1 lines 27-35 and col. 6 lines 60-61).
11. Whiteis also teaches (claim 75) displaying some of the additional items (*result items*, col. 4 lines 25-26). The limitation "on a shopping cart page" is nonfunctional descriptive matter (MPEP 2106.IV.B.1(b), first paragraph), and was accordingly given no weight. Neither reference teaches displaying on a web page (claim 102). However, Tagawa teaches displaying results from a network server, and an Internet connection. Because the WWW provides superior display capability, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add displaying results on a web page to the teachings of Whiteis and Tagawa.
12. Whiteis does not teach (claims 62, 73, 76, 77, 92, 93 and 98) generating recommendations in real time. Tagawa teaches an interactive electronic travel service (col. 4 lines 1-14), which reads on generating recommendations in real time.
13. Whiteis does not teach (claims 62, 73, 76, 77, 92, 93 and 98) multiple servers/machines. Tagawa teaches multiple servers/machines (col. 8 line 56).
14. Neither reference teaches (claims 63, 64, 90 and 101) a B-tree data structure. Because it is a well-known structure providing efficient lookup, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to store the table as a B-tree data structure.
15. Neither reference teaches (claims 78-80) making personalized recommendations without requiring an input list, an explicit request or preferences from the user. Because it is

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frequently profitable to advertise specials available according to demographics and other factors not requiring input from the user, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Whiteis and Tagawa making personalized recommendations without requiring an input list, an explicit request or preferences from the user.

16. Neither reference teaches (claim 103) filtering out items previously purchased by the target user. Because it can be pointless to recommend items that have already been purchased, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add filtering out items previously purchased by the target user to the teachings of Whiteis and Tagawa.

***Allowable Subject Matter***

17. Claims 68 and 84 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

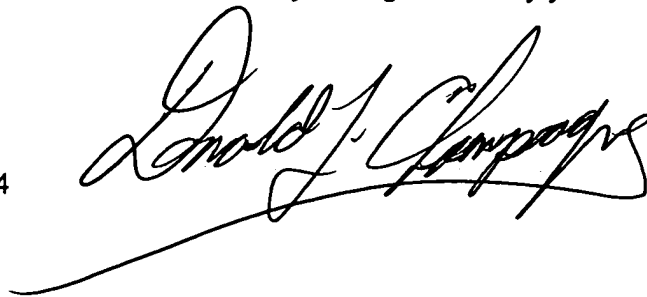
18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
19. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 703-308-3331. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at [donald.champagne@uspto.gov](mailto:donald.champagne@uspto.gov), and *informal*

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fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 703-746-5536.

21. The examiner's supervisor, Eric Stamber, can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5771.
22. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that "disposal or clarification for appeal may be accomplished with only nominal further consideration" (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.
23. Applicant may have after final arguments considered and amendments entered by filing an RCE.
24. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, [www.uspto.gov](http://www.uspto.gov). At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

20 August 2004

A large, stylized handwritten signature in black ink, which appears to read "Donald L. Champagne". The signature is written over a horizontal line and extends across the width of the signature block.

Donald L. Champagne  
Primary Examiner  
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